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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,598	09/27/2001	Gerhard Wennerstrom	1076.40715X00	9391
20457	7590	11/16/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/963,598	WENNERSTROM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jade O. Laye	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 September 2001.  
2a)  This action is **FINAL**.                            2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-27 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 27 September 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/20/01.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

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### ***Information Disclosure Statement***

I. The information disclosure statement (IDS) submitted on 12/20/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

II. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 2, Applicant uses the language "...received *contemporaneously* by the receiver." The term "contemporaneously" can be broadly defined as "during the same period of time," which the Examiner deems indefinite because a period of time could refer to any number of time periods including a second, hour, day, year, etc. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

III. Claims 1, 3, 5, 8, 9, 13, 15, 16, 18, 20-22, 24, 26, and 27 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Alexander et al. (US Pat. No. 6,177,931).

As to Claim 1, Alexander et al disclose a multimedia system comprising a receiver, data storage medium, data processor operable to record programming data and supplemental data (i.e., associated secondary program data) received via a communications channel, and a user interface which allows for the selection of said programming data and the retrieval of said supplemental data. (Abstract; Col. 1, Ln. 36-40; Col. 4, Ln. 28-44; Col. 7, Ln. 57-Col. 8, Ln. 3; Col. 19, Ln. 48-61; Col. 24, Ln. 10-15; Col. 32, Ln. 35-54; Col. 33, Ln. 44-65; Col. 34, Ln. 10-25). Accordingly, Alexander et al anticipate each and every limitation of Claim 1.

Claims 9, 16, 21, and 27 are encompassed within the limitations of Claim 1. Thus, each is analyzed and rejected as previously discussed. (*Note*: Regarding Claim 21, Alexander further teaches the associated program data (i.e., advertisements) can be analyzed/displayed (i.e., compiled) based on the programming watched by the user. (Col. 32, Ln. 22-Col. 34, Ln. 9). Regarding Claim 27, the Examiner considers the EPG containing various ad windows (Figure 1 of Alexander) to read upon Applicant's "menu of stored secondary programming data files...").

As to Claim 3, Alexander further teaches the supplemental data can comprise audio, video, text, or graphics. (Col. 24, Ln. 42-43; Col. 34, Ln. 15-16). Accordingly, Alexander et al anticipate each and every limitation of Claim 3.

Claims 18 and 24 correspond to Claim 3. Thus, it is analyzed and rejected as previously discussed.

As to Claim 5, Alexander further teaches the use of ad windows (i.e., data having lower resolution) within an EPG interface. (Figs. 14 and 16). For the sake of clarification, resolution can be defined as the number of pixels used to form an image. For example, the more pixels utilized to display an image, the higher the resolution of the display. Therefore, the smaller the image (i.e., Alexander's ad window), the lower the resolution. As such, Alexander is operable to display an ad window, which utilizes a lower resolution than the larger programming display. Accordingly, Alexander et al anticipate each and every limitation of Claim 5.

Claims 13, 20, and 26 correspond to Claim 5. Thus, each is analyzed and rejected as previously discussed.

As to Claim 8, Alexander et al further disclose the use of a display device. (clearly anticipated from cited portions used under Claim 1). Accordingly, Alexander et al anticipate each and every limitation of Claim 8.

Claim 15 corresponds to Claim 8. Thus, it is analyzed and rejected as previously discussed.

As to Claim 22, Alexander et al further disclose the system is operable to analyzed/display (i.e., compile) ads that are related to programs previously watched (i.e., earmarked) by the user. (Col. 33, Ln. 25-42). Accordingly, Alexander et al anticipate each and every limitation of Claim 22.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

IV. Claims 2 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in view of Kitsukawa et al. (US Pat. Pub. No. 2001/0013125).

Claim 2 recites the apparatus of Claim 1, further operable to record the primary and secondary program data when received contemporaneously by the receiver. As discussed above, Alexander et al anticipate each and every limitation of Claim 1, and further disclose the system is operable to record various programming. (portions cited under Claim 1). But, Alexander fails to disclose the remaining limitations of Claim 2. However, within the same field of endeavor, Kitsukawa discloses a similar system which is operable to receive both primary and secondary data contemporaneously. (Par. [0007, 0036, 0041]). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Alexander and Kitsukawa in order to provide a system which utilizes bandwidth more efficiently.

Claim 17 corresponds to Claim 2. Thus, it is analyzed and rejected as previously discussed.

V. Claims 4, 7, 12, 14, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al.

Claim 4 recites the apparatus of Claim 1, wherein the primary program data and the secondary programming data are in the form of MPEG-2 files. As discussed above, Alexander et al anticipate each and every limitation of 1, but fail to disclose the limitations of Claim 4. However, the Examiner takes Official Notice that, at the time of Applicant's invention, it was notoriously well known in this art to utilize MPEG-2 compression. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to

modify the teaching of Alexander to further include MPEG-2 compression, thereby providing a more bandwidth efficient transmission format.

Claims 12, 19, and 25 correspond to Claim 4. Thus, each is analyzed and rejected as previously discussed.

Claim 7 recites a set top box comprising the apparatus claimed in Claim 1. As discussed above, Alexander et al anticipate each and every limitation of Claim 1, but fail to specifically disclose the use of a set top box. However, the Examiner takes Official Notice that, at the time of Applicant's invention, the use of set top boxes were notoriously well known in this art as evidenced by *Kitsukawa et al*, US Pat. Pub. 2001/0013125, Figures 2 and 3. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to further modify the teachings of Alexander to incorporate the proposed invention in a set top box, thereby providing a compact, cost effective device which could be placed at the user site.

Claim 14 corresponds to Claim 7. Thus, it is analyzed and rejected as previously discussed.

VI. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in view of Berstis. (US Pat. No. 6,564,005).

Claim 6 recites the apparatus of Claim 1, wherein the processor is operable to selectively allow marking of the primary program data for deletion or prolonged keeping upon user input during display of the secondary program data. As discussed above, Alexander et al anticipate each and every limitation of Claim 1, but fail to disclose the limitations of Claim 6. However,

within the same field of endeavor, Berstis discloses a similar system which allows a user to select data for deletion and/or prolonged keeping. (Abstract; Col. 6, Ln. 38-54; Fig. 8). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Alexander and Berstis, thereby providing a multimedia system which provides the user with a flexible method of programming storage.

VII. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in view of Dunn et al. (US Pat. No. 5,945,987).

Claims 10 recites the apparatus of Claim 9, wherein the processor is operable to identify portions of the primary program data that have been earmarked and store a copy of said earmarked data in the associated secondary program data file. As discussed above, Alexander et al anticipate each and every limitation of Claim 9, but fail to specifically recite those of Claim 10. However, within the same field of endeavor, Dunn discloses a similar system which transmits video clips (i.e., secondary data) in a separate data file. (Abstract; Col. 2, Ln. 45-55; Col. 5, Ln. 16-28). For clarification, the Examiner interprets "...portions of the primary program data that have been earmarked..." to encompass video clips of primary programs stored on the system. Therefore, it is inherent these video clips comprise portions of the primary programs they advertise and the system subsequently stores a copy of these clips in their respective files. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Alexander and Dunn in order to provide a system which supplies the user with video clips, thereby influencing the user to purchase the corresponding video.

VIII. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of Dunn as applied to claim 10 above, and further in view of Logan et al. (US Pat. No. 5,892,536).

Claim 11 recites the apparatus of Claim 10, wherein the software agent is operable to replace at least a portion of audio data in the secondary program data with audio data from tertiary program data received by the receiver from the communication channel. As discussed above, the combined systems of Alexander and Dunn disclose all limitations of Claim 10, but fail to disclose those of Claim 11. However, within the same field of endeavor, Logan et al disclose a similar system which allows for the replacement of audio data with other audio data received via the communications channel. (Col. 2, Ln. 39-55; Col. 11, Ln. 63-Col. 12, Ln. 11). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Alexander, Dunn, and Logan, thereby providing a system which allows a user to edit background music during a commercial sequence.

VIX. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in view of Logan et al.

The limitations of Claim 23 mirror those of Claim 11. Therefore, the same discussion, analysis and cited portions of Logan used to reject Claim 11 are incorporated herein.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Lord et al (US Pat. No. 6,944,877) disclose a system which stores advertisements.
- b. Zigmund et al (US Pat. No. 6,698,020) disclose a system which stores advertisements.
- c. Barton (US Pat. Pub. No. 2001/0049820) disclose a system which stores advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
November 3, 2005.

  
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